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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT Application of Mills

Group Art Unit: 2881

Application Ser. No. 09/513,768

Examiner: Wells

Filed: February 25, 2000

For: ION CYCLOTRON POWER CONVERTER
AND RADIO MICROWAVE GENERATOR

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June 21, 2004

REQUESTS FOR WITHDRAWAL OF FINALITY UNDER MPEP § 706.07

-AND-

CONDITIONAL RULE 181 PETITION TO THE GROUP DIRECTOR

Hon. Asst. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

Applicant submits the following Requests and Conditional Petition in connection with two premature Final Rejections improperly entered by Examiner Wells in separate Office Actions dated July 29, 2002 and March 29, 2004:

- (1) Request for Response to Applicant's two prior Requests that the Examiner reconsider and withdraw the finality of the July 29, 2002 Office Action pursuant to MPEP § 706.07, which action led to the unnecessary filing of a Request for Continued Examination (RCE) in this case;
- (2) Request under MPEP § 706.07 that the Examiner reconsider and withdraw the finality of the pending March 29, 2004 Office Action, the first action following the filing of Applicant's RCE; and
- (3) Conditional Rule 181 Petition to the Group Director requesting reconsideration should the Examiner deny either of Applicant's Requests (1) or (2) above.

Applicant respectfully submits that the Final Office Action mailed July 29, 2002, prior to the filing of the RCE in this case, and the Final Office Action mailed March 29, 2004, after the RCE was filed, were both issued prematurely. Therefore, the finality of those Office Actions must be withdrawn under MPEP § 706.07 for the reasons set forth below.

Furthermore, because the premature finality of the July 29 Office Action caused the unnecessary filing of the RCE, this application should be treated as the originally filed case in accordance with a prior request by Applicant that was ignored by the Examiner.

A. Procedural Matters

1. Requests For Reconsideration Under MPEP § 706.07

As a matter of procedure, Applicant requests that the Examiner first take up Applicant's requests under MPEP § 706.07 to reconsider the finality of the July 29, 2002 and March 29, 2004 Office Actions. Those requests, having been filed during the pendency of the Final Office Actions complained of, must be considered timely filed under MPEP § 706.07(c), which provides:

706.07(c) Final Rejection, Premature

Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 C.F.R. 1.181. See MPEP § 1002.02(c).

Applicant's requests for reconsideration set forth sufficient grounds for a finding by the Examiner that the July 29, 2002 and the March 29, 2004 Final Office Actions were both premature under MPEP 706.07(d), which provides:

706.07(d) Final Rejection, Withdrawal of, Premature

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she

should withdraw the finality of the rejection. The finality of the Office action must be withdrawn while the application is still pending. The Examiner cannot vacate the final rejection once the application is abandoned.

Therefore, the finality of the July 29 and March 29 Office Actions must be withdrawn.

2. Conditional Rule 181 Petition

In accordance with MPEP § 706.07(c) above, should the Examiner deny either of Applicant's requests to reconsider and withdraw the premature final rejections issued in the July 29, 2002, and March 29, 2004 Office Actions, Applicant further requests that this Paper be considered as a petition to the Group Director under Rule 181 to review the Examiner's denial. See also MPEP § 1002(c)(3)(a). If a petition fee is required, please charge any deficiency to Applicant's Deposit Account No. 50-0687 under Order No. 62-226.

This Rule 181 petition, if necessary, must also be considered timely since it will have been filed within the two-month period for filing the petition under Rule 181(f), which does not begin to run until the Primary Examiner denies Applicant's initial request for reconsideration and withdrawal of the finality of the Office Action. See also MPEP § 1002 at p. 1000-2 ("37 CFR 1.181(f) provides that any petition under that rule which is not filed 'within 2 months from the action complained of may be dismissed as untimely.'")

B. Bases for Applicant's Requests For Withdrawal of Finality And, If Necessary, Rule 181 Petition To The Group Director

- 1. Request for a Response to Applicant's two prior Requests that the Examiner reconsider and withdraw the finality of the July 29, 2002 Office Action pursuant to MPEP § 706.07, which action led to the unnecessary filing of an RCE in this case**

Applicant has twice previously requested that the Examiner reconsider and withdraw the finality of the July 29, 2002 Office Action, only to have those requests ignored. Determined to get a fair hearing, Applicant once again seeks a favorable response to those prior requests.

a. First Prior Request to Withdraw Finality (in Response After Final)

The first request for reconsideration and withdrawal of the finality of the July 29, 2002 Office Action was presented in Applicant's "Amendment Under Rule 116 and Response to Final Office Action," filed January 29, 2003.¹ The basis for that request, which was wholly ignored in the Examiner's subsequently issued May 7, 2003 Advisory Action, is recounted below.

Applicant began by acknowledging the extent to which the July 29, 2002 Final Office Action, in reply to Applicant's January 28, 2002 Response, clarified certain positions taken by the Examiner in his first Office Action dated July 26, 2001. The July 29 Final Action began with the following summary of Applicant's January 28 Response:

[Applicant] made an in-depth analysis of the rebuttal of the rejection of the claims and pointed out the errors in the thinking of the Examiner as to the rejections in question.

* * *

The Applicant argued that the theory is substantiated by compelling experimental evidence which confirms the existence of a lower-energy hydrogen as carried out and presented by the Applicant (see "Response to the Office Action," pages 22-23). The Applicant construed that the Examiner did not analyze the experimental data as he mentioned (see "Response to the Office Action", page 3, lines 13-22) which is not the case. [July 29 Final Office Action at p. 2 (emphasis in original)]

¹ Applicant notes that certain errors in this Paper were corrected in replacement pages submitted in his "Supplemental Response to Final Office Action," filed April 1, 2003.

Applicant then noted that the above-cited passage of Applicant's January 28, 2002 Response contained the following quote from the prior July 26, 2001 Office Action (at p. 2), which Applicant interpreted as an admission by the Examiner that he had failed to analyze the experimental data submitted in support of the existence of lower-energy hydrogen:

The data presented in the Experimental section is not conclusive. Its analysis and any judgment upon its significance is outside the scope of the Examiner. [January 28, 2002 Response at p. 3 (emphasis added)]

Based upon this perceived admission, Applicant properly concluded that the Examiner "did not properly consider Applicant's disclosure and supporting experimental evidence" in rejecting Applicant's claims. Id.

In the July 29 Final Office Action, the Examiner clarified his previous remarks, claiming that he did analyze Applicant's scientific data:

In fact the Examiner did scrutinize the data and found an overwhelming amount of repetitive theoretical description, but found the compelling experimental evidence to be inconclusive as presented. It is the Examiner's opinion that the demonstration of the existence of a novel hydrogen species having lower energy states is best demonstrated by a shift in the Lyman series lines towards the far ultra-violet. This data should be compared to the regular hydrogen series. Unfortunately, this analysis and data is missing in the Applicant's experimental evidence presentation. [Final Office Action at p. 2 (emphasis in original)]

While Applicant appreciated the Examiner's views on the spectroscopic data, which helped advance the prosecution of this application, Applicant failed to understand why those helpful comments were not presented earlier in the first Office Action. The Examiner's prior statement in that Office Action that such "analysis and any judgment upon its significance is outside the scope of the Examiner" certainly conveyed to Applicant that his experimental evidence had been ignored. If that was not the case, the Examiner should have stated as much and identified the alleged deficiencies associated with Applicant's submitted evidence in the first Office Action, instead of

waiting until the Final Office Action to do so.

Nothing in Applicant's prior Response to that first Office Action—certainly not the criticism of the Examiner's failure to analyze Applicant's scientific data—justified the Examiner's delay in presenting that analysis. Simply put, it was blatantly unfair for the Examiner to claim he had considered Applicant's evidence in the first Office Action, but to then have waited until the Final Office Action to actually comment upon it. Applicant therefore requested that if the Examiner was still unpersuaded by the January 29, 2003 Response to the merits of his premature final rejections, that he at least withdraw the finality of the July 29, 2002 Office Action. [January 29, 2003 Response at p. 8.]

Applicant then proceeded to provide a detailed discussion addressing the merits of the July 29 Final Office Action. That discussion included an explanation of how the compelling experimental evidence of record, along with additional submitted evidence, complied with the Examiner's view that the existence of lower-energy hydrogen was "best demonstrated by a shift in the Lyman series lines towards the far ultra-violet . . . [as] compared to the regular hydrogen series." [Id. at 15-25.]

Applicant then pointed out in his January 29 Response how the Examiner had still failed to analyze the vast body of other experimental evidence that Applicant had submitted to confirm the existence of lower-energy hydrogen. Instead, the Examiner provided only vague comments characterizing Applicant's "compelling experimental evidence to be inconclusive as presented." [See July 29 Final Office Action at p. 2] While Applicant strongly disagreed with that characterization, it left Applicant to wonder why that compelling evidence was inconclusive as presented? How could that evidence, or some other scientific data, be present differently to be more conclusive? Absent that analysis, Applicant felt he had not been given a fair opportunity to address the Examiner's concerns. [See January 29, 2003 Response at p. 8-10.]

Applicant further pointed out that, even in the Examiner's limited consideration of Applicant's spectroscopic data, the July 29 Final Office Action still contained significant

gaps in the analysis of that data. [Id. at 10-12.] For example, the Examiner, while claiming to have considered that evidence, failed to articulate any specific reasons for rejecting its validity:

The Applicant claims (see page 26, lines 9-26; and page 117, lines 26-33) that the release of energy from hydrogen as evidenced by the extreme ultra-violet (EUV) emission must result in a lower energy state of hydrogen. The Examiner considered the evidence, but questions the validity of the experiments and why this EUV emission was not previously observed. [Final Office Action at p. 3]

As previously explained in Applicant's January 29, 2003 Response after final, for the Examiner to simply have stated that he had "considered the evidence," but questioned its validity, without providing any explanation for his reasoning was not only unhelpful, but also unfair. Again, such an approach provided no opportunity for Applicant to address the alleged deficiencies perceived by the Examiner. It obviously would have been more helpful if the Examiner had explained, in detail, why he questioned the validity of the experiments. Applicant expressed his concern that, without an understanding of the basis for the Examiner's skepticism, he was at a distinct disadvantage in his attempts to convince the Examiner otherwise.

Regarding the merits of the Examiner's new, albeit limited, analysis of Applicant's spectroscopic data, that analysis raised two basic points of disagreement. First, the Examiner mistakenly stated that Applicant's data demonstrating the existence of lower-energy hydrogen, as "best demonstrated by a shift in the Lyman series lines," was missing a comparison of those lines to the lines of the "regular hydrogen series." Applicant, however, had already provided that conclusive spectroscopic data and, in response to the Examiner's characterization of that data as the "best" evidence, Applicant provided further comparative data for the Examiner's consideration. As previously noted, much of that scientific data can be found in published, or soon to be published, peer-reviewed articles appearing in prestigious scientific journals.

Second, while Applicant agreed that this spectroscopic data is highly probative

on the issue of lower-energy hydrogen's existence, that evidence should not have been analyzed to the exclusion of other probative data submitted on that same issue. Once again, Applicant supplemented that evidence in his January 29, 2003 response after final with the expectation that the Examiner would fully consider it and, if found deficient, he would provide adequate feedback to allow Applicant a fair opportunity for rebuttal.

Unfortunately, that was not the case. Not only did the Examiner completely ignore Applicant's request to withdraw the finality of the July 29, 2002 Office Action, but he then issued another 20-page substantive "Detailed Action" (including Appendix), comprised mostly of new arguments, but disguised as an "Advisory Action." [See May 7, 2003 Advisory Action]

b. Second Prior Request to Withdraw Finality (in RCE)

Faced with a procedural dilemma, Applicant had no choice but to file the August 19, 2003 RCE pursuant to 37 C.F.R. § 1.114. As explained on page 2 of the RCE:

This RCE application is necessitated by the PTO's continuing failure to properly consider the extensive scientific evidence of record proving the existence of lower-energy hydrogen, i.e., "hydrinos," underlying his claimed invention. This failure resulted in the entry of a premature Final Rejection in this case.

Applicant then renewed his prior request to reconsider and withdraw the finality of the July 29, 2002 Office Action. [See August 19, 2003 RCE at p. 2.] As part of that renewed request, Applicant first registered his strong objection to the use of the May 7, 2003 Advisory Action to supply, in the Examiner's own words, "key analysis and discussion" that was obviously missing from the July 29 Final Office Action. Because the Examiner supplemented the substantive grounds of rejection, and that supplementation was not done in response to any of Applicant's Rule 116 amendments, Applicant argued once again for the withdrawal of the finality of the July

29 Office Action.² [Citing MPEP § 706.07]

As Applicant further noted on page 2 of the RCE, the Examiner helped make the case for withdrawing finality by quoting in his May 7, 2003 Advisory Action (at pp. 2-3) Applicant's prior objections to the obvious shortcomings of the July 29, 2002 Final Office Action:

In applying the present Section 101 rejection the Examiner . . . improperly presumes the utility of Applicant's invention to be per se incredible, while ignoring the vast majority of theoretical explanation and experimental evidence supporting that utility. For instance, the Examiner has not yet provided any explanation of how the extensive theory disclosed in the present specification is in error and why the supporting experimental evidence does not demonstrate the utility of what Applicant is claiming. Instead, the Examiner continues to violate Section 101 standards by merely concluding that "the invention is based upon assumptions that are contrary to basic, well established, laws of quantum physics and, therefore, is inoperative and lacks utility." [July 29, 2002 Final Office Action at p. 4]

The Examiner did not dispute the bases for those objections. Rather, the Examiner confirmed the substantive deficiencies of the July 29, 2002 Final Office Action on page 3 of his Advisory Action by treating Applicant's objections as a "challenge" necessitating a substantive response:

Thus the applicant challenges the Examiner to provide an explanation of errors found in the extensive theory disclosed in the present specification

² The only amendments submitted under Rule 116 were minor ones to claims 4-10, which in no way necessitated the extensive substantive grounds of rejection newly advanced by the Examiner. [See "Amendment Under Rule 116 and Response to Final Office Action," dated January 29, 2003, pp. 1-8] As indicated on page 8 of that Amendment, claim 4 was amended to remove an example of the electrical load. Claims 5-10 were amended to refer to the microwave power source, power converter, and radio and microwave generator of claim 1 to provide antecedent basis. None of those amendments were made to overcome prior art, to limit the claim scope in any way, or to add new matter.

and errors in the supporting experimental evidence. The Examiner's arguments are as follows:

The Examiner then proceeded to supply some, though not all, of the missing information complained of by Applicant, including what he described as "key analysis and discussion provided in the [16-page] Appendix." [Advisory Action at p. 5 (emphasis added)] While this "key analysis and discussion" lacked any merit, that did not excuse the fact that this admittedly important information should have been presented earlier to give Applicant a fair opportunity to respond prior to the entry of the final rejection.

Applicant further noted in his RCE the irony in the Examiner including "key analysis and discussion" in his May 7 Advisory Action relating to the rejections of record, while ignoring the request for reconsideration and withdrawal of the finality of the July 29, 2002 Office Action found in Applicant's Rule 116 Amendment that criticized the delay in supplying such important information. [See January 29, 2003 Rule 116 Amendment at pp. 8-13]

More specifically, Applicant pointed out how the Examiner partially explained for the very first time in his Advisory Action the missing reasoning behind the prior vague statements in his Final Office Action finding Applicant's "compelling experimental evidence to be inconclusive as presented." The fact that the Examiner did so by relying on self-described "key analysis and discussion" included in a 16-page Appendix merely confirmed previously expressed concerns that Applicant had not been given a fair opportunity to address and overcome the final rejections of record.

Accordingly, Applicant renewed his previous request to withdraw the finality of the July 29, 2002 Final Office Action. Applicant further gave notice to the Examiner on how his RCE should have been treated: "If this request [to withdraw finality] is granted, as it should be, then the Examiner need not act on Applicant's [RCE] in this case, but rather, should treat this filing as a response to a non-final Office Action." [August 19, 2003 Request for Continuing Examination at p. 5.]

In yet another bit of irony, the Examiner completely ignored Applicant's second request—as he had the first—for withdrawal of the finality of the July 29 Office Action, and then responded to Applicant's RCE by issuing a first action final rejection in the case. [See March 29, 2003 Final Office Action.] In light of the Examiner's refusal to address the finality of the July 29, 2002 Office Action raised in two prior requests, Applicant again seeks to have the Examiner consider those requests and take appropriate action by: (1) withdrawing the finality of the July 29, 2002 Office Action; and (2) treating Applicant's filing of the RCE in this case, which should have been unnecessary, as a response to a Non-Final Office Action.

2. Request under MPEP § 706.07 that the Examiner reconsider and withdraw the finality of the pending March 29, 2004 Office Action, the first action following the filing of Applicant's RCE

Applicant respectfully submits that, separate and apart from the premature finality of the July 29, 2002 Office Action, the finality of the present March 29, 2004 Office Action is also premature due, in part, to the introduction of many new grounds of rejection presented in a 22-page "Detailed Action" (including Appendix) supplementing the July 29 Office Action. For this reason and others presented below, the finality of the March 29 Office Action, the first action following the filing of Applicant's RCE, should also be withdrawn.

MPEP § 706.07(h), sub-part VIII, governs when it is appropriate to make a first action final after filing an RCE:

706.07(h) Request for Continued Examination (RCE) Practice

* * *

VIII. FIRST ACTION FINAL AFTER FILING AN RCE

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.

As quoted above, the conditions for making a first action final in a continuing application are spelled out in MPEP § 706.07(b), which provides:

706.07(b) Final Rejection, When Proper on First Action

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

In a superficial attempt to satisfy those conditions, the Examiner issued the following general statement appearing on page 5, paragraph 4, at the end of the March 29 Final Office Action:

4. All claims are drawn to the same invention claimed in the application prior to the entry of the submissions under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and submission under MPEP 706.07(b). [Emphasis in original.]

While the Examiner parrots the language of MPEP § 706.07(b), he fails to articulate any pertinent facts supporting his finality decision. This is not surprising, since the facts merely highlight the prematurity of that decision, which was based upon the faulty assumption that Applicant's submission "could have been finally rejected" if submitted prior to entry under 37 CFR § 1.114.

Even if it were true that the submission could have been finally rejected if presented earlier, the fact remains that the Examiner did not rely exclusively on the "grounds and art of record" in the Final Office Action presently under consideration. Instead, the Examiner relied on new grounds and arguments that went beyond responding to Applicant's arguments and provided additional analysis that was missing

from earlier Office Actions. Ignoring this fact, the Examiner improperly made the recent March 29, 2004 Office Action final.

Applicant views this latest questionable action taken by the Examiner as a continuation of the unfair treatment Applicant has come to expect in the examination this and other pending BlackLight applications. The troubling procedural history of these cases is well documented in the papers on file and, therefore, Applicant will forego here a full accounting of the sordid details. Suffice it to say that, following the initial allowance of five BlackLight applications that were subsequently withdrawn from issue under highly suspicious circumstances, the PTO has articulated many different positions and legal standards—oftentimes contradicting one another—while failing to properly consider the bulk of Applicant's supporting scientific evidence.

Applicant has pointed out these failures in numerous papers throughout the prosecution of this case, including his "Amendment Under Rule 116 and Response to Final Office Action" filed January 29, 2003. In that Paper, as discussed above, Applicant noted many of the serious defects contained in the prior Final Office Action dated July 29, 2002, including a detailed discussion of how the Examiner misconstrued Applicant's experimental evidence.

Determined to get a fair hearing on his evidence, Applicant filed the present Request for Continued Examination (RCE) under 37 CFR § 1.114 on August 19, 2003. In that RCE, Applicant submitted new scientific evidence demonstrating the existence of lower-energy hydrogen and highlighted certain deficiencies found in the Examiner's previous Office Action related to his improper analysis of Applicant's data.

In apparent recognition of those deficiencies, the Examiner, in his first, but final, response to Applicant's RCE, again cited new arguments in his 22-page "Detailed Action" of March 29, 2004. For instance, the Examiner now alleges newly discovered mathematical and conceptual errors supposedly associated with Applicant's theory in addition to those discussed in previous Office Actions and cites several new references

in support of those allegations. The Examiner further articulates additional reasoning, not previously presented, claiming, incorrectly, that "not only is the hydrino hypothesis highly speculative, but physically wrong" because, supposedly, it is based on "many misunderstandings of conventional quantum mechanics, electromagnetic theory and the theory of relativity, as pointed out in detail in the [17-page] Appendix." [March 29, 2004 Final Office Action at p. 5.] The Examiner offers no explanation why, once again, he waited until issuing a final rejection before providing this additional reasoning in support of that rejection.

In addition, the Examiner claims in his first and final Office Action that "there are many other physically plausible explanations (see Appendix)" for the hydrogen line broadening recited in Applicant's experimental papers. [Id. at p. 4] Because, however, these explanations include ones not articulated in prior Office Actions, the March 29 Office Action should not have been made final for this reason as well.

Similarly, the Examiner articulates other new arguments on which he bases the rejection of Applicant's claims that could have been included in prior Office Actions, thus requiring withdrawal of the finality of the present Office Action. Included among these offending items are, for example, newly presented arguments and citation of additional references: (1) explaining supposed sample contamination affecting Applicants TOF-SIMS data (Appendix p. 6); (2) claiming that Applicant's papers do not include reference to lower-energy hydrogen, i.e., "hydrinos," or hydrogen states with fractional energy levels (Appendix p. 12); and (3) alleging why Applicant's experimental evidence is unconvincing or his theory is invalid. In each case, because these newly crafted arguments on which the Examiner bases his rejections could have been presented earlier, they preclude the issuance of a first action Final Rejection.

Furthermore, in filing the RCE in this case, Applicant made a good faith attempt to respond to the Examiner's misplaced criticisms articulated in a prior Office Action that, as explained above, should never have been made Final. Part of that effort included the submission of new scientific evidence demonstrating the existence of

lower-energy hydrogen. The Examiner's attempt in the present final, first Office Action to wholly dismiss this latest submission is itself highly improper in failing to give Applicant a fair and adequate opportunity to respond.

Finally, the Examiner advances entirely new positions, even ones contradicting positions taken in previous Office Actions. For instance, on page 3, paragraph (2) of the attached Appendix, the Examiner states:

Contrary to Applicant's allegation on pg.13, 1st full paragraph, lines 2-4, the PTO's view is not at all that the existence of lower-energy hydrogen were [sic] impossible, but instead, that (a) Applicant's invention is not supported by any experimental fact or evidence, and (b) the underlying theory (i.e., GUT/CQM) fails to support the invention, because it contains too many flaws. A few of such flaws have been already exposed in the May 7 Appendix, none of which have been persuasively argued or refuted by Applicant in the RCE, as will be demonstrated in the next section(s).

Even a cursory examination of the record, however, shows that, indeed, the PTO has consistently taken the position—until the recent first and final Office Action—that the existence of lower-energy hydrogen is an impossibility for an assortment of reasons shown to have no basis in fact. For instance, the Examiner claimed on page 5 of his first premature Final Office Action, dated July 29, 2002, that, according to modern-day quantum physics, the existence of lower-energy hydrogen “is not possible”:

A hydrogen atom with its electron in a lower than “ground state” energy level corresponds to a fractional quantum number (defined in the invention as a hydrino) which, up to now, is not possible by contemporary quantum physics. [Emphasis in original.]

The Examiner made it even more clear on page 6 of that Office Action, in summarizing his rejection under 35 U.S.C. § 101, that the creation and use of lower-energy hydrogen is impossible:

In summary, the claimed invention is inoperative and, therefore lacks utility since it is based upon the creation and use of a novel hydrogen species and compositions of matter that are impossible by contemporary quantum physics and that have not been shown to exist. [Emphasis added.]

For the Examiner to articulate an entirely new, contradictory position that "the PTO's view is not at all that the existence of lower-energy hydrogen [is] impossible." in a first and final Office Action is highly improper and should not be countenanced.

In sum, while the Examiner perhaps, hypothetically, could have stuck with the grounds and authorities of record previously cited against Applicant to maintain his rejection of the present claims, he chose not to do that. Instead, the Examiner articulated new grounds and cited new authorities to expand upon his limited analysis of the evidence that was already of record and to address to a limited extent Applicant's newly submitted evidence. Having done so, the Examiner improperly made final the first Office Action following Applicant's filing of the RCE in this case. Consequently, the finality of that March 29, 2003 Office Action must be withdrawn.

**3. Conditional Rule 181 Petition to the Group Director
requesting reconsideration should the Examiner deny
either of Applicant's Requests (1) or (2) above**

In accordance with MPEP § 706.07(c), should the Examiner deny Applicant's requests to withdraw the premature final rejections issued in the July 29, 2002, and March 29, 2004 Office Actions, Applicant further requests that this Paper be considered a petition to the Group Director under Rule 181 to review the Examiner's denial of those requests. See also MPEP § 1002(c)(3)(a). If a petition fee is required, please charge any deficiency to Applicant's Deposit Account No. 50-0687 under Order No. 62-226.

CONCLUSION

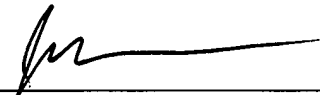
For the foregoing reasons, Applicant respectfully submits that the Final Office Action dated July 29, 2002, prior to the filing of the RCE in this case, and the Final Office Action dated March 29, 2004, after the RCE was filed, were both issued prematurely. Therefore, under MPEP § 706.07, the finality of those Office Actions must be withdrawn.

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Furthermore, because the premature finality of the July 29 Office Action caused the unnecessary filing of the RCE in this case, this application should be treated as the originally filed case in accordance with Applicant's prior request.

Respectfully submitted,

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